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Paper No. 7

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JUN 25 2001

**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of :
Maass, Bergmann, Herwig, Jutzi, :
Cardine, Grimm, Strauss, Drewniak, : DECISION REFUSING STATUS
Killner, Wurm, Hof, Dobson, Schang, : UNDER 37 CFR 1.47(a)
and Keyes :
Application No. 09/672,393 :
Filed: 28 September, 2000 :
Attorney Docket No. 60,130-899 :

This is in response to the petition under 37 CFR 1.47(a), filed on 16 April, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on 28 July, 2000, without an executed oath or declaration.

Accordingly, on 13 November, 2000, a "Notice To File Missing Parts of Nonprovisional Application" was mailed, requiring, the basic filing fee, an executed declaration, a surcharge for their late filing, as well as a multiple dependent claim surcharge.

In response, on 16 April, 2001 (certificate of mailing date 13 April, 2001), the present petition was filed. The petition was accompanied by:

- (1) The petition fee of \$130.00;
- (2) Request and payment for a three (3) month extension of time;

- (3) The basic filing fee;
- (4) A declaration executed by joint inventors Klaus-Peter Maass, Uwe Bergmann, Arnd G. Herwig, Stefan Jutzi, Patrice Cardine, Rainer Grimm, Klaus-Dieter Strauss, Daniel Drowniok, Harald Kollner, Georg Wurm, Patrick Hof, Simon Blair Dobson, and Kenneth W Schang on behalf of themselves and non-signing joint inventor Gregory Keyes, and
- (5) A preliminary amendment.

Petitioners state that Keyes cannot be located. Petitioners assert that a copy of a draft of the application was mailed, via Federal Express, to joint inventor Keyes at his last known address, but that no response was received.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The present petition lacks items (1).

Petitioners must present a showing that diligent efforts have been made to locate the non-signing inventor.¹ The showing of record is insufficient to prove that diligent efforts were made to locate the non-signing inventor. Petitioner should explain what attempts were made to obtain a forwarding address and to locate the inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. though e-mail, telephone, national registry) continue to fail, then applicant will have established that the inventor cannot be reached. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that the application was mailed and other attempts, such as telephone calls or e-mail searches, were made should be included.

¹MPEP 409.03(d).

As petitioners state that Dr. Horst Schumacher has attempted to locate joint inventor Keyes, petitioners should provide an affidavit or declaration of facts from Schumacher explaining in detail the efforts made to locate Keyes.

Additionally, if Keyes is located but refuses in writing to sign the declaration, petitioners should provide a copy of that written refusal with any renewed petition. If there an oral refusal to sign is made to a person, details should be given in an affidavit or declaration of facts by a person having first hand knowledge of the facts of refusal.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

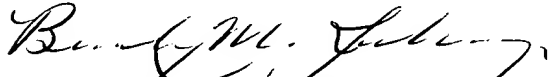
By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703) 308-6918.



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